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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Skillen et al.

Serial No: 09/351,747

Filing Date: July 8, 1999

Title: ASSOCIATIVE SEARCH ENGINE

Examiner: David Yiuk Jung

Art Group: 2134

Docket No: HQ0045A

Date: 9/7/04

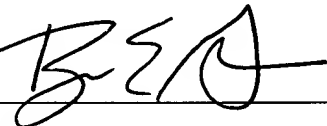
Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPELLANT'S BRIEF PURSUANT TO 37 C.F.R. § 1.192

In accordance with a Notice of Appeal filed on July 7, 2004, the applicant hereby submits:

1. Appellant's Brief (in triplicate);
2. Credit Card Payment form in the amount of \$330 for filing of a brief in support of an appeal; and
3. Transmittal Postcard.

RESPECTFULLY SUBMITTED,

By: 

Bruce E. Garlick

Registration No. 36,520

Phone: (512) 264-8816

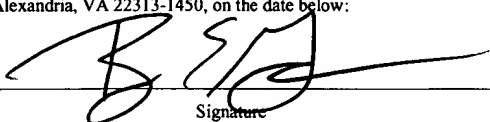
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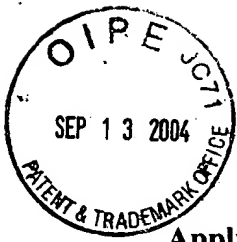
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September 7, 2004

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Signature



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APPELLANT'S BRIEF PURSUANT TO 37 C.F.R. § 1.192

In accordance with a Notice of Appeal filed on July 7, 2004, the applicants submit this appellant's brief.

1. Fee: Enclosed herewith is a credit card payment form for the fee of \$330 for filing of a brief in support of an appeal.

2. Real Party in Interest: All rights to the above referenced patent application have been assigned to:

Nortel Networks Limited
2351 Boulevard Alfred-Nobel
St. Laurent, Quebec
Canada, H4S 2A9

3. Related Appeals and Interferences: There are no known other appeals or interferences that would directly or indirectly affect the Board's decision in the present appeal.

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4. Status of the Claims: Claims 1-6, 9, 11-19, 75-79, 107, and 108 are pending. Claims 7, 8, 10, 20-74, 80-106, and 109-113 are cancelled.

Claims 1-6, 9, 11-19, 75-79, 107, and 108 stand rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0749081A1, Pointcast Inc., "Pointcast" and "The Search Engine Report," dated July 23, 1996 ("Sullivan"). These rejections were made in an Office Action mailed June 11, 2003 and reiterated in the Final Office Action mailed April 6, 2004.

5. Statement of Amendments: No amendments have been made subsequent to the Final Office Action that was mailed on April 6, 2004.

6. Summary of the Invention:

Generally, providing search results and advertisements to a user searching for desired information within a data network. Operation commences with receiving, from the user, a search request including a search argument corresponding to the desired information. Operation continues with searching, based upon the received search argument, a first database having data network related information to generate search results. Operation continues with correlating the received search argument to a particular advertisement in a second database having advertisement related information. Operation concludes with providing the search results together with the particular advertisement to the user.

Independent claim 1 is a method claim that includes these operations. Independent claim 9 is a system claim having means for performing these operations.

Independent claim 11 is a method claim requiring particular data network devices to perform these operations. Independent claim 75 is a system claim directed to an advertising machine having elements that perform these operations. Claims 2-6, 12-19, and 76-79 depend from claims 1, 9, 11, and 75, respectively.

Independent claim 107 is a system claim directed to an advertising machine having elements that perform these operations and that also alter their own operations based upon whether the advertisement was successful. Claim 108 depends from claim 107.

7. Issue: The applicants contend that claims 1-6, 9, 11-19, 75-79, 107, and 108 are not obvious under 35 U.S.C. 103(a) over Pointcast and Sullivan.

8. Grouping of the Claims:

Group I: Claims 1-6, 9, 11-19, and 75-79 are grouped for argument with respect to the 35 U.S.C. §103(a) rejection.

Group II: Claims 107 and 108 are grouped for argument with respect to the 35 U.S.C. §103(a) rejection.

9. Argument:

The cited references are first discussed. Then, the Examiner's arguments are addressed.

The Pointcast Reference

Pointcast is directed to a system in which advertisements are first statically assigned to information items on an Information Server. The information items and assigned advertisements are then downloaded together from the Information Server to a user's workstation and stored in the workstation's local memory. When the workstation meets predefined idleness criteria, an information display controller of the workstation causes information items and assigned advertisements to be displayed to the user on the workstation's display. Subscriber profile data may be used to assist in selecting information items and assigned advertisements to be displayed. (Pointcast Abstract at page 1, Summary at page 3, and Description at pages 4-5). Pointcast therefore discloses a system that statically assigns advertisements to information items at an Information Server, periodically downloads information items and assigned advertisements to the workstation, and then displays information items and assigned advertisements to the user on the workstation when the workstation is idle.

The Sullivan Reference

The Sullivan Reference is a trade publication that discusses current issues relating to Search Engines. The Sullivan reference Search Engine Report discloses that, as of July 23, 1996, controversy regarding the sale of keywords existed. (Sullivan page 1 of 3) When a keyword is "sold" to a purchaser by a search engine provider, the seller's search engine will list the purchaser's web page as the first search result (or one of the first search results) when the "sold" keyword is searched. While this practice is common today, as of July 23, 1996 this practice was relatively new.

Pointcast and Sullivan do not render claims 1-6, 9, 11-19, and 75-79 obvious.

Claim 1 requires: (a) receiving, from a user, a search request including a search argument corresponding to the desired information; (b) searching, based upon the received search argument, a first database having data network related information to generate search results; (c) correlating the received search argument to a particular advertisement in a second database having advertisement related information; and (d) providing the search results together with the particular advertisement to the user.

The Examiner argues that Pointcast (at Page 9, Table 1) discloses: “receiving, from the user, a search request including a search argument corresponding to the desired information”. Table 1 of Pointcast is directed to the operation of a screen saver. The operations of Table 1 have NOTHING to do with the receipt of a search request from a user. As described in Pointcast at page 8 line 50, the procedures of Table 1 are invoked when NO USER INPUT is received, quite different than “receiving, from the user, a search request including a search argument corresponding to the desired information”.

The Examiner argues that Pointcast (at Page 9, Table 1) discloses: “searching, based upon the received search argument, a first database having data network related information to generate search results.” This portion of Pointcast is directed to the operation of a Screen Saver that displays information items and assigned advertisements upon a determination of user inactivity. Pointcast does not disclose, suggest, or teach searching of a database based upon a received search argument.

The Examiner argues that Pointcast (at Page 12, Table 2) discloses: “correlating the received search argument to a particular advertisement in a second database having

advertisement related information.” This portion of Pointcast is directed to the update of the database of a workstation with new information items and advertisements. This portion of Pointcast does NOT disclose, suggest, or teach correlating the received search argument to a particular advertisement in a second database having advertisement related information as required by the claim element at issue.

The Examiner argues that Pointcast (at Page 12, Table 2) discloses “providing the search results together with the particular advertisement to the user”. Table 2 of Pointcast is directed primarily to the update of the database of a workstation with new information items and advertisements. While Pointcast does disclose providing information items and advertisements to a user, Pointcast does not disclose providing search results to a user. Pointcast discloses providing content and advertisements to a user that were downloaded in bulk from an Information server and then displayed upon user inactivity.

With regard to Sullivan, the Examiner argues that "selling of keywords" is equivalent to “correlating the received search argument to a particular advertisement in a second database having advertisement related information”. As described above, “selling keywords” affects how search results are presented to a user, i.e., ordering search results based upon the "sold" keywords. In no way does Sullivan describe correlating a search argument to a particular advertisement in a second database search as required by claim 1 of the present application.

Independent claim 9 is a system claim having means for performing the operations described with reference to claim 1. Independent claim 11 is a method claim requiring particular data network devices for performing the operations described with reference to claim 1. Independent claim 75 is a system claim directed to an advertising

machine having elements that perform the operations described with reference to claim 1. Claims 2-6, 12-19, and 76-79 depend from claims 1, 9, 11, and 75, respectively. For these reasons Pointcast and Sullivan do not render claims 1-6, 9, 11-19, and 75-79 obvious.

Pointcast and Sullivan do not render claims 107 and 108 obvious.

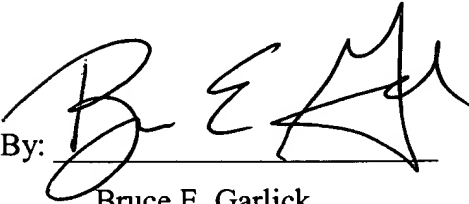
Claim 107 is a system claim directed to an advertising machine. The advertising machine includes limitations of claim 75 and also includes limitations requiring: (1) whether the advertisement (provided to the user) was successful; and (2) altering subsequent correlations of received search arguments to the second database. Claim 108 depends from claim 107 and includes additional limitations regarding the use of user profile data for the correlation.

As described above, Pointcast and Sullivan fail to render obvious claim 75. For this reason Pointcast and Sullivan fail to render obvious claim 107. Further, claim 107 includes the additional above-described additional limitations that are also not disclosed, suggested, or taught by Pointcast and/or Sullivan.

Conclusion:

For the above-provided reasons, the Appellants respectfully request that the foregoing rejections be overturned and that the claims in the present application be allowed to issue.

RESPECTFULLY SUBMITTED,

By: 

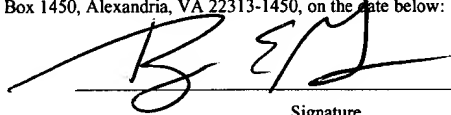
Bruce E. Garlick
Registration No. 36,520
Phone: (512) 264-8816
Fax No. (512) 264-3735

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Copy of Claims

1. (original) A method of providing advertisements to a user searching for desired information within a data network, comprising the steps of:

receiving, from the user, a search request including a search argument corresponding to the desired information;

searching, based upon the received search argument, a first database having data network related information to generate search results;

correlating the received search argument to a particular advertisement in a second database having advertisement related information; and

providing the search results together with the particular advertisement to the user.

2. (original) A method as claimed in claim 1, wherein the step of correlating the received search argument to the particular advertisement including selecting the particular advertisement based on the received search argument and user profile data.

3. (original) A method as claimed in claim 2, wherein the user profile data includes selections of the user from previous search arguments.

4. (original) A method as claimed in claim 3, wherein the user profile data includes selections of the user from previous search results.

5. (original) A method as claimed in claim 4, wherein the user profile data includes user specified preferences.

6. (original) A method as claimed in claim 1, wherein the step of providing the search results and the particular advertisement to the user includes displaying the search results as a page on a data processing device and the particular advertisement as an insert on the page.

Claims 7 - 8. (cancelled)

9. (original) A system for providing advertisements to a user searching for desired information within a data network, comprising:

means for receiving, from the user a search request including a search argument corresponding to the desired information;

means for searching, based upon the received search argument, a first database having data network related information to generate search results;

means for correlating the received search argument to a particular advertisement in a second database having advertisement related information; and

means for providing the search results together with the particular advertisement to the user.

10. (cancelled)

11. (original) A method of providing advertisements to a user searching for desired information within a data network, comprising the steps of:

receiving, at a server, a search request sent from a user, the search request including a search argument corresponding to the desired information;

searching, by the server computer based upon the received search argument, a first database to generate search results, the first database having data network related information and being contained on the server computer;

correlating the received search argument to a particular advertisement in a second database having advertisement related information, the second database contained on a client computer; and

providing the search results together with the particular advertisement to the user.

12. (original) A method as claimed in claim 11, wherein the step of correlating the received search argument to the particular advertisement includes selecting the particular advertisement based on the received search argument and user profile data.

13. (original) A method as claimed in claim 12, wherein the user profile data is based partially upon previous search arguments of the user.

14. (original) A method as claimed in claim 13, wherein the user profile data is based partially upon previous search results for the user.

15. (original) A method as claimed in claim 14, wherein the user profile data includes user specified preferences.

16. (original) A method as claimed in claim 11, wherein the step of providing the search results and the particular advertisement to the user includes displaying the search results as a page on a data processing device and the particular advertisement as an insert on the page.

17. (original) A method as claimed in claim 11, wherein the step of correlating the received search argument to a particular advertisement in the second database is performed by the client computer.

18. (original) A method as claimed in claim 11, wherein:
the server computer is a database search engine computer; and
the client computer is an access provider computer.

19. (original) A method as claimed in claim 11, wherein:
the server computer is a database search engine computer; and
the client computer is an associate search engine computer.

Claims 20 - 74 (cancelled)

75. (original) An advertising machine for providing advertisements to a user searching for desired information within a data network, the advertising machine comprising:

a server computer coupled to the data network that receives a search request from the user, the search request including a search argument corresponding to the desired information;

a database search engine coupled to the server computer that receives the search argument from the server computer and searches a first database to generate search results, the first database having data network related information and being contained on the server computer;

an associative search engine coupled to the server computer that correlates the received search argument to a particular advertisement in a second database having advertisement related information, the second database contained on a client computer; and

the server computer providing the search results together with the particular advertisement to the user.

76. (original) The advertising machine of claim 75, wherein the associative search engine selects the particular advertisement based on the received search argument and user profile data.

77. (original) The advertising machine of claim 76, wherein the user profile data is based partially upon previous search arguments of the user.

78. (original) The advertising machine of claim 76, wherein the user profile data is based partially upon previous search results for the user.

79. (original) The advertising machine of claim 76, wherein the user profile data includes user specified preferences.

Claims 80-106 (canceled)

107. (original) An advertising machine coupled to a data network for providing advertisements to a user, the advertising machine comprising:

a server computer coupled to the data network that receives a search request from the user, the search request including a search argument corresponding to the desired information;

a database search engine coupled to the server computer that receives the search argument from the server computer and searches a first database to generate search results, the first database having data network related information and being contained on the server computer;

an associative search engine coupled to the server computer that correlates the received search argument to a particular advertisement in a second database having advertisement related information, the second database contained on a client computer;

the server computer providing the search results together with the particular advertisement to the user;

the server computer determining whether the advertisement was successful; and

the server computer altering criteria for subsequent correlations of received search arguments to the second database.

108. (original) The advertising machine of claim 107, wherein the associative search engine correlates the received search argument to the particular advertisement based on the received search argument and user profile data.

Claims 109 - 113 (cancelled)